

REMARKS

Status Of The Claims

The Office Action dated March 5, 2003 has been reviewed, and its contents carefully considered. Claims 1-20 are pending. Claims 1, 8 and 15 are independent.

Reconsideration and withdrawal of the outstanding rejections are respectfully requested in view of the following remarks.

Office Action

Claims 1, 3, 6, 8-9, 11, 15-16, 18 and 20 were rejected under 35 U.S.C. § 102(b) as being anticipated by Hara et al. This rejection is respectfully traversed for the following reasons.

Hara et al. discloses a spectral diagnosing apparatus with an endoscope. Claim 1 of the present invention recites, *inter alia*, “a flexible viewing scope apparatus comprising...a flexible viewing scope connected to a first end of a fiber optic cable...an eyepiece having an eyepiece lens connected to a second end of said fiber optic cable...and a source of ultraviolet light provided at the second end of said fiber optic cable.” Claim 8 of the present invention recites, *inter alia*, “illuminating an object with an ultraviolet light...viewing the object through an eyepiece having an eyepiece lens with a flexible viewing scope through a fiber optic cable connected at a first end to the flexible viewing scope and at a second end to said eyepiece.” Finally, claim 15 of the present invention recites, *inter alia*, “means for illuminating an object with an ultraviolet light...means for viewing the object through an eyepiece having an eyepiece lens with a flexible viewing scope through a fiber optic cable connected at a first end to the flexible viewing scope and at a second end to the eyepiece.” The Examiner’s rejection purports

that the features as recited in the claims are taught by Hara et al. However, upon closer inspection of Hara et al., it is respectfully submitted that the claimed features are not anticipated.

For example, the Examiner recites three embodiments of Hara et al.'s disclosure to attempt to anticipate the claimed features of the present invention. The embodiment shown in FIG. 3 depicts an electronic scope 2 having a light source section 3 and an objective lens 10 located at tip 9 on an elongate flexible insertable section 8. However, the embodiment shown in FIG. 3 lacks a teaching of "an eyepiece having an eyepiece lens" and "source of ultraviolet light provided at the second end of said fiber optic cable" as recited in claim 1 and similarly in claims 8 and 15. Hara et al. merely teaches a light source section 3 and lacks a specific teaching of ultraviolet light provided at the second end of the fiber optic cable as recited, for instance, in claim 1 and similarly in claims 8 and 15.

The Examiner relies on a second embodiment shown in FIG. 12 to attempt to teach an eyepiece section 92 of fiber scope 91. However, the embodiment shown in FIG. 12 does not teach "a source of ultraviolet light provided at the second end of said fiber optic cable" as recited, for instance, in claim 1 and similarly in claims 8 and 15. The arrangement of providing a light source on the second embodiment of Hara et al. is disclosed to be similar to the first embodiment of Hara et al. which, as already mentioned, does not teach providing ultraviolet light (see Hara et al., column 10, lines 67-68).

Finally, the Examiner refers to FIG. 14 to disclose another embodiment including a video processor 146 emitting light in a wide band from ultraviolet rays or infrared rays. However, the embodiments shown in FIG. 14 lacks a teaching of "an eyepiece having an eyepiece lens connected to a second end of said fiber optic cable" in combination with a source of ultraviolet light as recited, for instance, in claim 1 and similarly in claims 8 and 15.

Further, notwithstanding the deficiencies of Hara et al., the rejection's proposed combinations of elements from three different embodiments of Hara et al. is not proper. To the contrary, the disclosure of Hara et al. does not teach the combination of all the features recited in claims 1, 8 and/or 15. For anticipation under 35 U.S.C. §102 the reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present (M.P.E.P. 706.02). Since each and every element, as set forth in the claim, is not found either expressly or inherently described as required by the M.P.E.P, Hara et al. cannot be said to anticipate the present invention as claimed. Thus, withdrawal of the rejection is respectfully requested.

Claims 3 and 6 ultimately depend from independent claim 1 and are patentable over the cited prior art for at least the same reasons as is claim 1.

Claims 9, 11 and 13 ultimately depend from independent claim 8 and are patentable over the cited prior art for at least the same reasons as is claim 8.

Claims 16, 18 and 20 ultimately depend from independent claim 15 and are patentable over the cited prior art for at least the same reasons as is claim 15.

Claims 2, 4-5, 7, 10, 12, 14, 17 and 19 were rejected under 35 U.S.C. § 103 as being unpatentable over Hara et al. in view of Lobb et al. and Tamburrino.

Regarding claims 2, 4-5 and 7, they ultimately depend from independent claim 1 which is patentable over Hara et al. for the reasons listed above. Lobb et al. does not cure the deficiencies

of Hara et al. because, *inter alia*, it does not provide the combined structure of a flexible viewing scope connected to a first end of a fiber optic cable, an eyepiece having an eyepiece lens connected to a second end of the fiber optic cable, and a source of ultraviolet light provided at the second end of the fiber optic cable as recited in claim 1.

Likewise, Tamburrino does not cure the deficiencies of Hara et al. because, it, too, does not provide the claimed combined structure of a flexible viewing scope connected to a first end of a fiber optic cable, and an eyepiece having an eyepiece lens connected to a second end of a fiber optic cable and a source of ultraviolet light provided at the second end of the fiber optic cable as recited in claim 1.

In accordance with the M.P.E.P. §2143.03, to establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re: Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re: Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494 196 (CCPA 1970). Since all the claim limitations are not taught or suggested by Hara et al., alone or in combination with Lobb et al. and Tamburrino, withdrawal of the rejection is respectfully requested.

Regarding claims 10, 12 and 14, the aforementioned claims ultimately depend from independent claim 8 which is patentable over Hara et al. for the reasons listed above. Lobb et al. does not cure the deficiencies of Hara et al., because the combined method of leak detection including illuminating an object with an ultraviolet and viewing the object through an eyepiece having an eyepiece lens as recited in claim 8 is not taught. Additionally, Tamburrino does not cure the deficiencies of Hara et al., because the combined method of leak detection as recited in

claim 8 is not taught. Hence, withdrawal of the rejection is respectfully submitted since Hara et al., alone or in combination with Lobb et al. and Tamburrino, lacks all the features as claimed.

Regarding claims 17 and 19, the aforementioned claims ultimately depend from independent claim 15 which is patentable over Hara et al. for the reasons listed above. Lobb et al. does not cure the deficiencies of Hara et al. because it lacks a teaching of a means for illuminating an object with an ultraviolet light in combination with a means for viewing the object through an eyepiece having an eyepiece lens as recited in claim 15. Additionally, Tamburrino does not cure the deficiencies of Hara et al., because it, too, lacks a teaching of a means for illuminating an object with an ultraviolet light in combination with a means for viewing the object through an eyepiece having an eyepiece lens as recited in claim 15. Hence, Hara et al., alone or in combination with Lobb et al. and Tamburrino, cannot be said to teach or suggest the present invention as claimed. Therefore, withdrawal of the rejection is respectfully requested.

Conclusion

In view of the foregoing remarks, reconsideration and allowance of the application are believed in order and such action is earnestly solicited.

Should the Examiner believe that a telephone conference would expedite issuance of the application, the Examiner is respectfully invited to telephone the undersigned Patent Agent at (202) 861-1538.

Respectfully submitted,

BAKER & HOSTETLER LLP

A handwritten signature in black ink, appearing to read 'Marc W. Butler', with a long horizontal flourish extending to the right.

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